

Appl. No. 09/774,968
Amdt. Dated: 06/25/2004
Response to Office action dated: 06/17/2004

REMARKS

Claims 1-40 are pending. Claims 30 and 33 have been amended. No new claims have been added and no claims have been canceled.

Claim Rejections - 35 USC § 101

The Office Action rejects claims 30 and 33 under 35 USC § 101 as being directed to non-statutory subject matter. Claims 30 and 33 have been amended as set forth above to overcome this rejection. As such, this rejection should be withdrawn.

Claim Rejections - 35 USC § 102

The Office Action rejects claims 1-11 under 35 USC § 102(e) as anticipated by West (US 6,081,508). This rejection is respectfully traversed.

The MPEP 706.02 states that under 35 USC § 102(e), a prior art "reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." In this rejection, the Office Action addresses each limitation included in the claims by listing what the Examiner believes to be corresponding elements from West. However, the Office Action fails to state the interrelationship and interaction of the elements as recited in the claims. The Office Action fails to explain where West teach any of the method steps recited in the claims. What the Office Action does is describe a list of part, but fails to explain how they should be put together to create a system that performs a method. The parts remain separate and are not connected in any way in the arguments presented in the Office Action.

Regarding claim 1, the Examiner asserts that the user NAN list comprising plural NANs is taught at col. 2, lines 20-23 of West, that the client device is taught by element 100 in Fig. 1 of West, that a data network is taught by element 340 of Fig. 4 of West, and that a server system is taught by elements 140 and 224 of Figs. 1 and 4 of West. However, the Examiner fails to assert or show "a user network access number (NAN) list, the user NAN list comprising plural NANs, the NANs for use by a user's client device in connecting to a data network under control of a server system" as

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recited in claim 1. More specifically, the Examiner fails to show "the NANs for use by a user's client device in connecting to a data network" and "a data network under control of a server system." as recited in claim 1. That is, even though *in arguendo* West may teach a "NAN list", a "client device", and a "data network", the Examiner has failed to assert how West teaches "NANs for use by a user's client device in connecting to a data network." Even though West may *in arguendo* teach a "data network" and a "server system", the Examiner has failed to assert that West teaches "a data network under control of a server system."

The Office Action then asserts that West teaches "storing in the server system connection information about connecting from the NANs in the available NAN list to the data network" at col. 3, lines 35-45. However, this cited portion of West fails to mention element 100 of Fig. 1 that the Office Action asserts teaches the client device and element 340 of Fig. 4 that the Office Action asserts teaches the data network. The Office Action fails to explain how element 100 of Fig. 1 and element 340 of Fig. 4 are connected in any way with the text at col. 3, lines 35-45.

We could go on with regard to other elements in claim 1 and elements in claims 1-11, but there is no point in doing so, as the Examiner has wholly failed to assert how every element of the claims is taught by West. The Office Action merely provides a list of elements of West which the Office Action asserts teach features recited in claims 1-11. However, the Office Action fails in each and every instance to put the puzzle of the pieces together by failing to show how the pieces, if *in arguendo* they are taught by West, are used in conjunction with one another to achieve the recited claims. As such, the Office Action fails to show where West teaches each and every method step recited in the claims.

We hereby request that the June Office Action be re-issued to include arguments asserting not just that the "parts" recited in the claims are arguably taught by West, but how every aspect recited in claims 1-11 is taught by West, particularly the method steps.

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In an effort to move prosecution forward, we will address some elements recited in the claims which the Examiner asserts are taught in West.

Regarding claim 1 and all claims dependent thereon, we disagree with the Office Action that West teaches "an available NAN list of NANs available for the client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list" stored in the server system." A NAN list is a list of telephone numbers (para. 9 of the Patent Application). Although West mentions "a dialing database which includes telephone numbers" at col. 3, lines 1-4, this portion of West cited in the Office Action fails to teach "setting the NANs in the user NAN list based upon the available NAN list." The Office Action also fails to explain what in West corresponds to the "available NAN list" and the "user NAN list." Further, although West mentions "determining a set of access paths at col. 2, lines 58-63, this portion of West fails to teach "setting an order for selecting the NANs in the user NAN list based upon the connection information, wherein the order is set outside of the user's control" as recited in claim 1. That is, "determining a set" does not teach "setting an order" as claimed. Grouping such as "determining a set" does not teach or imply ordering. As such, the Office Action fails to show where West teaches the claimed limitation

Regarding claim 2, the Office Action asserts that the portion of West which states that

The execution of the software can also feature accepting performance related logging information from remote computers and updating the performance related cost factors based on the logging information.
West, col. 3, lines 55-58

teaches "associating ranking information with at least one NAN in the user NAN list" as recited in claim 2. However, the cited portion of West merely states that performance related logging information is accepted from remote computers and performance related cost factors are updated. In this cited portion of West, there is no mention of "associating ranking information with at least one NAN" as claimed. As such, the Office Action fails to show where West teaches the claimed limitation.

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Regarding claim 4, the Office Action asserts that col. 6, lines 37-64 of West teach "providing a sequence list which identifies the order" as recited in the claim. However, the actions performed in this portion of West describe a list sorted by cost derived from monetary and performance factors. (West, col. 6, lines 37-64). Such a sorted list is not the same as and fails to teach "providing a sequence list which identifies the order" as claimed. As such, the Office Action fails to show where West teaches the claimed limitation.

Regarding claim 5, the Office Action asserts that col. 6, lines 37-64 of West teach "providing the client device with connection information for the NANs in the user NAN list and an algorithm for selecting the NANs based on the provided connection information." However, this portion of West merely teaches using connection software on a remote computer (what the Office Action states corresponds to the client device) to list connection paths and sort them based on cost. There is no teaching in this portion of West of "providing the client device with connection information for the NANs in the user NAN list and an algorithm for selecting the NANs based on the provided connection information." As such, the Office Action fails to show where West teaches the claimed limitations.

Regarding claim 6, the Examiner, although attempting to list those elements which the Examiner asserts are present in West, fails to assert where and how the functionality of the claimed elements are taught by West. The Office Action fails to show where West teaches the "plural backend networks", the "plural backend providers", the association between the plural backend networks and the plural backend providers, "a cost from the back end provider for the client device to utilize the back end network of the back end provider", and "the back end providers permit a connection through their back end networks to the client device under the authorization of the server system." As such, the Office Action fails to show where West teaches each and every aspect of the claimed limitations.

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Further, the Office Action confusingly states that element 140 corresponds to the "plural back end networks" and the "back end providers" of claim 6 and the "server system" of claim 1. Clarification is hereby requested.

Regarding claim 7, the Examiner asserts that col, 2, lines 58-63 of West teach "determining an available local NAN list based upon the location of the client device and the location information for the NANs in the available NAN list." However, review of this portion of West reveals that mention is only made of the location of a remote computer. In this portion of West, no mention is made of "the location of the NANs in the available NAN list." The telephone list discussed at this portion of West describes telephone access charges associated with dialed telephone channels, and fails to mention the location of telephone numbers. As such, the Office Action fails to show where West teaches each and every aspect of the claimed limitations.

Continuing with regard to claim 7, the Examiner asserts that col, 6, lines 37-58 of West teach "comparing the available local NAN list with the user NAN list to identify a good NAN in the available local NAN list which is not in the user NAN list." However, this portion of West fails to teach an "available local NAN list" and a "user NAN list" as claimed. In addition, there is no teaching of the limitation "to identify a good NAN in the available local NAN list which is not in the user NAN list." As such, the Office Action fails to show where West teaches each and every aspect of the claimed limitations.

Regarding claim 9, the cited portion of West fails to teach "asking the user for permission to add the good NAN to the user NAN list." The cited portion of West merely teaches that "a user may be given the right to reorder the list, or to otherwise indicate that a path is not the lowest cost path is his preferred choice." (West, col. 6, lines 51-55) Reordering a list and selecting a path from a list as taught in this portion of West are not the same as and do not teach "asking the user for permission to add the good NAN to the user NAN list" as recited in the claim. As such, the Office Action fails to show where West teaches the claimed limitation.

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Regarding claim 10, the cited portions of West fail to teach "comparing the available local NAN list with the user NAN list to identify a bad NAN in the user NAN list which is not in the available local NAN list" and "deleting the bad NAN from the user NAN list." Further, the reference to col. 14, lines 45-52 of West appears to be misplaced and inapplicable to this claim. As such, the Office Action fails to show where West teaches the claimed limitations.

Regarding claim 11, the cited portion of West fails to teach "asking the user for permission to delete the bad NAN from the user NAN list." The cited portion of West merely teaches that "a user may be given the right to reorder the list, or to otherwise indicate that a path is not the lowest cost path is his preferred choice." (West, col. 6, lines 51-55) Reordering a list and selecting a path from a list as taught in this portion of West are not the same as and do not teach "asking the user for permission to delete the bad NAN from the user NAN list" as recited in the claim. As such, the Office Action fails to show where West teaches the claimed limitation.

For all of the reasons set forth above, Claims 1-11 are patentable over West.

Claim Rejections - 35 USC § 103

The Office Action rejects claims 12-40 under 35 USC § 103(a) as obvious in view of the combination of West and Dieterman. (US 20020013896). This rejection is respectfully traversed.

To the extent claims 12-40 include limitations like those in claims 1-11, the arguments presented above concerning the 102(e) rejection of claims 1-11 are incorporated herein and are applicable to this rejection, including the arguments regarding the insufficiency of the rejection. As above, because the Office Action fails to set forth with particularity where each and every one of the claim elements is taught or suggested in the combination of West and Dieterman, we request that the Office Action be re-issued.

In this rejection, the Examiner states that West fails to teach that the server is an online service provider. However, this is not so. We direct the Examiner to col. 30, lines 58-65 of West.

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As such, the reference to Dieterman, if used for the purpose of teaching an online service provider is unnecessary, as this is achieved in West..

For all of the reasons set forth above, Claims 2-40 are patentable over West.

Conclusion

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: June 25, 2004



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